

II. Claim Rejections under 35 U.S.C. § 102

A rejection under § 102 is only proper when the claimed subject matter, in this case a method of protecting keratinous fiber from extrinsic damage, is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. See M.P.E.P. § 2131.

A. *Ruiseco*

Claims 1 and 10 - 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Ruiseco* (U.S. Patent No. 4,849,214) ("*Ruiseco*") for the reasons set forth on page 3 of the present Office Action. Applicants respectfully traverse this rejection.

The present claims relate to a method of protecting keratinous fiber from extrinsic damage. *Ruiseco* does not teach protection of keratinous fiber from extrinsic damage according to the present invention. In contrast, *Ruiseco* discloses "treatment of dry skin and scalp conditions," for example, at col. 1, line 9 - 11, and a "method for the treatment of hair loss in a patient undergoing treatment for angina or radiation therapy." See *e.g.*, claim 4 of *Ruiseco*. According to the present invention, extrinsic damage is damage to keratinous fiber "that is caused by conditions such as sun, chemical damage, *e.g.*, from detergents, bleaching, relaxing, dyeing, and permanent

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waving, and heat, e.g., from hair dryers or curlers." See e.g., page 6 of the present application. Accordingly, the treatment of hair loss caused by cancer radiation therapy or medication is not protection of keratinous fiber from extrinsic damage according to the present invention.

For at least this reason, Applicants submit that *Ruiseco* does not identically describe the invention according to the present claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Konishi

Claims 1 and 10 - 12 stand under 35 U.S.C. § 102(b) as being anticipated by *Konishi et al.* (J.P. 62,099,319) ("*Konishi*") for the reasons set forth on page 3 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that "*Konishi*, like the instantly claimed method, teaches a one-step process of applying to the hair and skin an herbal tonic comprising an extract of mistletoe and an extract of *Angelic pubescens Maxim.*, in an amount of 0.1 to 5% of the total dried material in the hair tonic composition." See page 3 of the present Office Action. However, in contrast to the Examiner's assertion, *Konishi* does not teach application to hair. Should the Examiner maintain this rejection, Applicants request that the Examiner point to the disclosure relied upon for teaching "applying to the hair" so that Applicants may respond to this assertion.

Further, the Examiner concludes that, "as *Konishi* teaches that the mistletoe alone has remarkable trichogenous effect, the method taught by *Konishi* is a method of protecting keratinous fiber from extrinsic damage." See pages 3-4 of the present Office Action. However, Applicants fail to see how a trichogenous effect, that is, a hair-producing or hair-generating effect, equates to protection of keratinous fiber from extrinsic damage. As in *Ruiseco*, *Konishi* is at best a treatment of the scalp not keratinous fiber. Accordingly, Applicants request that the Examiner explain this assertion and point to the disclosure in *Konishi* teaching or suggesting protection of keratinous fiber so that Applicants may adequately respond to this assertion.

As *Konishi* does not disclose a method of protecting keratinous fiber from extrinsic damage comprising applying to the keratinous fiber a composition comprising at least one plant extract of the present invention, Applicants respectfully request that this rejection be withdrawn.

C. Bradbury

Claims 1 - 3, 7 and 9 - 11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Bradbury et al.* (U.S. Patent No. 4,849,214) ("*Bradbury*") for the reasons set forth on page 4 of the present Office Action. Applicants respectfully traverse this rejection.

Bradbury does not identically describe or disclose the method of the present claims for at least the following reasons. The Examiner states that "*Bradbury* teaches a

method of topically applying to hair a composition comprising sucrose and willowherb (*Epilobium*)." See page 4 of the present Office Action. The Examiner also asserts that "the claimed functional effect of protecting hair from extrinsic damage is inherent to the method taught by *Bradbury*." *Id.* Applicants respectfully disagree.

In contrast to the Examiner's assertion, *Bradbury* discloses a "method for regulating the growth and loss of hair via the use of compositions containing a compound selected from the group consisting of lupane triterpenes, derivatives of lupane triterpenes, derivatives of oleanane triterpenes, derivatives of ursane triterpenes, and salts and mixtures thereof." See Abstract. One lupane triterpene disclosed in *Bradbury* is betulinic acid. "Betulinic acid may be obtained commercially as pure betulinic acid, synthesized according to known methods, or can be extracted from a plant." See col. 7, lines 53-55 (emphasis added). One of the 239 plant genres disclosed in *Bradbury* as being non-limiting examples of those which **may** contain betulinic acid is *Epilobium*. See col. 7, line 55 - col. 8, line 45. Thus, *Bradbury* teaches a composition which may comprise a specific molecule, a lupane triterpene, which may be obtained, *inter alia*, via extraction from, *inter alia*, willowherb plants.

In contrast to the Examiner's assertion regarding inherency, M.P.E.P. § 2112 makes clear that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic—the result or characteristic must necessarily be present in the prior art (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993))

(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art)).

Applicants cannot find any basis for the Examiner's claim of inherency, nor has the Examiner provided any such basis. *Bradbury* discloses a method for regulating the growth and loss of hair *via* the use of compositions containing a compound selected from a specific group which includes a specific compound, a lupane triterpene. *Bradbury* simply lists 239 plant genres which **may** contain this compound and there is no specific example or teaching of the use of willowherb extract. Thus, the use of willowherb, as claimed herein, is not necessarily present in the prior art. Accordingly, Applicants request that the Examiner point to the disclosure teaching or suggesting protection of keratinous fiber so that Applicants may adequately respond to this assertion.

For at least the foregoing reasons, *Bradbury* does not anticipate the present method of protecting keratinous fiber from extrinsic conditions, and Applicants respectfully request that this rejection be withdrawn.

D. Carson

Claims 1 - 4, 6 - 7, and 10 - 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Carson et al.* (U.S. Patent No. 5,416,075) ("*Carson*") for the reasons set forth on pages 4 - 5 of the present Office Action. Applicants respectfully traverse this rejection.

Applicants assert that *Carson* does not identically describe or disclose the method of the present claims for at least the following reasons. *Carson* does not disclose at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. See e.g., col. 11, lines 59 - 60. The Examiner asserts that "[s]uitable oils or lipophilic compounds taught by *Carson* include evening primrose (willow herb extract) and avocado oil." Applicants respectfully disagree with this characterization of *Carson's* disclosure. In contrast to the Examiner's assertion that willow herb extract is disclosed, *Carson* discloses various oils, including essential oils such as evening primrose oil and avocado oil. Essential oils are not plant extracts according to the present invention. See e.g., International Cosmetic Ingredient Dictionary and Handbook, Eighth Edition, Vol. 2, Section 3, 2000 (classifying into chemical classes plant extracts as "Biological Products" at p. 1646 and essential oils as "Essential Oils" at p. 1669).

Accordingly, Applicants submit that *Carson* does not identically describe or disclose the invention according to the present claims for at least the foregoing reasons, and Applicants respectfully request that this rejection be withdrawn.

E. Tolpa

Claims 1 - 3 and 10 - 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Tolpa et al.* (U.S. Patent No. 5,747,050) ("*Tolpa*") for the reasons set

forth on pages 6 - 7 of the present Office Action. Applicants respectfully traverse this rejection.

The Examiner asserts that "*Tolpa* expressly teaches a one-step method of applying to keratinous fiber, namely hair, a composition comprising herbal wheat germ extract, and at least one sugar." See page 7 of the present Office Action. Applicants respectfully disagree. Although, *Tolpa* does disclose that cosmetic milks for application to **skin** frequently contain suitable herb extracts like camomile extract or wheat germ extract at col. 8, lines 15 - 29, nowhere does *Tolpa* teach a method of applying to **keratinous fiber** a composition comprising at least one plant extract chosen from potato extract, mistletoe extract, avocado extract, wheat germ extract, and willowherb extract. Accordingly, Applicants request that the Examiner point to the disclosure teaching or suggesting protection of keratinous fiber so that Applicants may adequately respond to this assertion.

Accordingly, for at least this reason, *Tolpa* does not anticipate the present claims, and respectfully request withdrawal of this rejection.

III. Claim Rejections under 35 U.S.C. § 103

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Carson* or *Tolpa*, in view of *Ruiseco*, and further in view of *Konishi* for the reasons set forth on pages 8 - 9 of the present Office Action. Applicants respectfully traverse this rejection.

In order to establish a *prima facie* case of obviousness, the Examiner must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. See M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In the present case, the Examiner has failed to make a *prima facie* case of obviousness because this criteria has not been met.

The Examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made and one would have had a reasonable expectation of success to substitute the plant extracts taught by *Carson* and *Tolpa* to provide the claimed invention because *Ruiseco* and *Tolpa*, respectively, teach the beneficial effects of incorporating extracts of avocado and mistletoe in the making of compositions, which are used in the methods for the protection of keratinous fiber from extrinsic damage." See page 9 of the present Office Action.

As discussed in their reply of August 10, 2001, even if, *arguendo*, *Carson* or *Tolpa* were modified by *Ruiseco* and *Konishi* in the manner suggested by the Examiner, the resultant modification would not render the present claims obvious because that combination would not teach or suggest all of the limitations of the present claims because *Carson*, *Tolpa*, *Ruiseco* and *Konishi* do not disclose a method of protecting

keratinous from extrinsic damage. Therefore, for at least this reason, Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness.

Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01 (emphasis in original). The Examiner asserts that "*Tolpa* and *Carson* provid[e] the motivation to apply to keratinous fiber a composition comprising at least one plant extract..., *Ruiseco* provid[es] the motivation to apply to the hair avocado extract for treatment against extrinsic damage caused by the use of heart medicine, and exposure to chemotherapy and radiation, and finally...*Konishi* disclosing a mistletoe comprising hair formulation with trichogenous effect which promotes hair growth without skin irritation." See page 9 of the present Office Action. Applicants respectfully disagree.

As *Carson*, *Tolpa*, *Ruiseco* and *Konishi* teach the use of different chemical compounds to form different products via different methods for different purposes, one of ordinary skill in the art would not have been motivated to modify *Carson* or *Tolpa* as the Examiner suggests using *Ruiseco* and *Konishi*. The basis of the Examiner's argument to combine the cited references appears to rest on the assertion that *Tolpa* and *Carson* provide the motivation to apply to keratinous fiber a composition comprising at least one plant extract. However, *Carson* is drawn to an oil-in-water emulsion comprising an aqueous phase, an oil phase and an emulsifier system which comprises an amphiphathic compound. See e.g., Claim 1. Among the various optional

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ingredients disclosed, *Carson* lists eleven classes as "[e]xamples of conventional adjuncts which can **optionally** be employed." See col. 11, lines 49-66. "[P]lant extracts such as Aloe vera, cornflower, witch hazel, elderflower, [and] cucumber" comprise only one class of optional adjuncts. See col. 11, lines 59-60. Thus, *Carson* hardly provides the motivation to apply to keratinous fiber a composition comprising at least one plant extract.

The Examiner asserts that "*Tolpa* expressly teaches that the choice of the plant extract used in the method' [sic] composition for the protection of keratinous tissue depends on the desired target surface and the beneficial bioactivity exerted by the plant extract on the target surface." See page 9 of the present Office Action. Applicants could not find any such "express teaching," and accordingly, request that the Examiner point to the disclosure she is referring to so that Applicants may adequately respond to this assertion

In regard to *Ruiseco*, the Examiner relies on the assertion that *Ruiseco* provid[es] the motivation to apply to the hair avocado extract for treatment against extrinsic damage caused by the use of heart medicine, and exposure to chemotherapy and radiation. However, as discussed with respect to the rejection under 35 U.S.C. § 102 above, and in contrast to the Examiner's assertion, *Ruiseco* does not provide the motivation to apply to the hair avocado extract to keratinous fiber for treatment against extrinsic damage according to the present invention.

Further, *Ruiseco* teaches away from the use of its compositions to protect hair from extrinsic damage according to the present invention. Specifically, *Ruiseco* teaches that "the treatment [disclosed therein] is most effective when high heat is used." See col. 3, lines 41-42. However, according to the present invention, extrinsic damage includes heat. Accordingly, the method disclosed in *Ruiseco* does not protect keratinous fibers from extrinsic damage as defined in the present application.

Finally, there would have been no motivation to combine *Carson* or *Tolpa* and *Konishi*. *Konishi* discloses a hair tonic containing an extract of mistletoe. This tonic has "very remarkable trichogenous and hair growth promoting effect [sic] by application." However, neither *Carson* nor *Tolpa* disclose the use of mistletoe nor the desirability of such a trichogenous effect. In fact, neither of the aforementioned references mentions hair loss, hair growth or anything similar.

Therefore, neither *Ruiseco*, *Konishi*, *Carson*, nor *Tolpa* provide the requisite motivation to modify the references in the manner suggested by the Examiner. Accordingly, for at least the foregoing reasons, the modification of *Carson* or *Tolpa* by *Ruiseco* and *Konishi* fails to render the present claims obvious, and Applicants respectfully request the withdrawal of these rejections.

IV. Provisional Double Patenting Rejection

Claims 1 - 13 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 13 of

copending Application No. 09/527,599 for the reasons set forth on pages 11 -12 of the present Office Action. Applicants respectfully traverse this rejection, but, at this time, respectfully request that this rejection be held in abeyance until allowable subject matter is indicated. At that time, Applicants will consider whether or not to file a Terminal Disclaimer.

V. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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